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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,416	12/05/2003	John Berge	RDYN.M. 13/US	8376

25871 7590 09/14/2004  
SWANSON & BRATSCHUN L.L.C.  
1745 SHEA CENTER DRIVE  
SUITE 330  
HIGHLANDS RANCH, CO 80129

EXAMINER
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AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,416

Applicant(s)

BERGE ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6 and 7 is/are rejected.
- 7) ☒ Claim(s) 2 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-7 are pending in the application.

#### ***Specification***

2. The disclosure is objected to because of the following informalities:

The filing date of priority document is listed as December 6, 2002 under cross-reference. However, the priority date is listed as December 5, 2002 in the oath. The priority document is also not present in the application. Appropriate correction is required.

#### ***Claim Objections***

3. Claims 4 and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternate only. See MPEP § 608.01(n).

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3, 4, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the value of variable R2 defined as ---the residue of ---- is vague and indefinite since its meaning is not clear. Is it different from 5 or 6-membered heteroaryl ring?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation salts, and the claim also recites pharmaceutically acceptable salts which is the narrower statement of the range/limitation.

Claim 3 recites the limitation "substance" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

In claim 4, the term ---according to claim 1 --- is vague and should be deleted. Claim 4 depends upon claim 3 which in turn depends upon claim 1 and therefore, there is no need for this term.

In claim 6, the term ---according to claim 1 --- is vague and should be deleted. Claim 6 depends upon claim 5 which in turn depends upon claim 1 and therefore, there is no need for this term.

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In claim 7, formula (I) is missing and furthermore, all the variables are not defined. The applicants are suggested to make claim 7 dependent upon claim 1 to overcome this rejection.

In claim 7, page 56, line 4, the term ---or an activated derivative thereof --- is indefinite since its meaning or intent is not clear.

***Allowable Subject Matter***

6. The following is a statement of reasons for the indication of allowable subject matter:

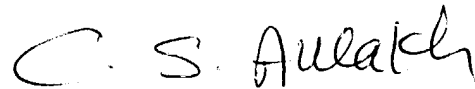
The instant compounds of formula (I), a process for preparing them and a method of treating bacterial infections using these compounds are allowable over the prior art since they are neither disclosed nor obvious over the prior art. In the prior art, Elder ( WO 00/71522 ) discloses Benzimidazole derivatives having identical utility which are closely related to the instant compounds. However, the compounds of Elder differ in structure from the instant compounds in having a phenyl ring fused to imidazole ring ( instant variable R<sub>2</sub> ) instead of a 5 or 6-membered heteroaryl ring and furthermore, there is no teaching, suggestion or motivation in the prior art to modify the compounds of Elder to prepare the instant compounds without affecting their utility of antibacterial activity.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charanjit S. Aulakh  
Primary Examiner  
Art Unit 1625